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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/284,152	06/03/1999	MARK AARON EMALFARB	3123-4000US2	1956

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EUGENE MOROZ
MORGAN & FINNEGAN
345 PARK AVENUE
NEW YORK, NY 10154

EXAMINER

FRONDA, CHRISTIAN L

ART UNIT

PAPER NUMBER

1652

DATE MAILED: 04/08/2003

22

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/284,152

Applicant(s)

Emalfarb et al.

Examiner

Christian L. Fronda

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above, claim(s) 5 and 9-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Mar 29, 2001 is/are a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other: _____

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DETAILED ACTION

Election/Restriction

1. Applicants' election without traverse of Group I, claims 1-4 and 6-8, in Paper No. 11 is acknowledged. Claims 5 and 9-21 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. The requirement is still deemed proper and is therefore made FINAL.
2. Claims 1-4 and 6-8 are under consideration in this Office Action.

Priority

3. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on 1/13/2000. It is noted, however, that applicant has not filed a certified copy of the 100 01 101.2 application as required by 35 U.S.C. 119(b).
4. Claims 1-4 and 6-8 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claimed invention encompass any polynucleotide that is at least 70% identical to a polynucleotide encoding a polypeptide that contains the amino acid sequence of SEQ ID NO: 2, a polynucleotide that encodes a polypeptide that is at least 70% identical to the amino acid sequence of SEQ ID NO: 2, and a polynucleotide containing at least 15 successive nucleotides thereof. The specification, however, only provides the following representative species encompassed by the invention: an isolated polynucleotide consisting of SEQ ID NO: 1. There is no disclosure of any particular structure to function/activity relationship in the single disclosed species. The specification also fails to describe additional representative species of these polynucleotides by any identifying structural characteristics or properties for which no predictability of structure is apparent. Given this lack of additional representative species as encompassed by the claims, Applicants have failed to sufficiently describe the claimed invention, in such full, clear, concise, and exact terms that a skilled artisan would recognize Applicants were in possession of the claimed invention. Claims 2-4 and 6-8 which depend from claim 1 are also rejected because they do not correct the defect of claim 1.
5. Claims 1-4, 7, and 8 are rejected under 35 U.S.C. 112, first paragraph, because the

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specification, while being enabling for an isolated polynucleotide encoding a polypeptide comprising the amino acid sequence of SEQ ID NO:2 or an isolated polynucleotide comprising SEQ ID NO: 1; does not reasonably provide enablement for any other embodiment.

Factors to be considered in determining whether undue experimentation is required, are summarized in *re Wands* [858 F.2d 731, 8 USPQ 2nd 1400 (Fed. Cir. 1988)]. The *Wands* factors are: (a) the quantity of experimentation necessary, (b) the amount of direction or guidance presented, (c) the presence or absence of working example, (d) the nature of the invention, (e) the state of the prior art, (f) the relative skill of those in the art, (g) the predictability or unpredictability of the art, and (h) the breadth of the claim.

The nature and breadth of the claims encompass any polynucleotide that is at least 70% identical to a polynucleotide encoding a polypeptide that contains the amino acid sequence of SEQ ID NO: 2, a polynucleotide that encodes a polypeptide that is at least 70% identical to the amino acid sequence of SEQ ID NO: 2, and a polynucleotide containing at least 15 successive nucleotides thereof

The specification provides guidance and examples for making an isolated polynucleotide encoding a polypeptide comprising the amino acid sequence of SEQ ID NO:2 or an isolated polynucleotide comprising SEQ ID NO: 1. However, the specification does not teach the specific structural/catalytic amino acids and the structural motifs essential for protein activity/function which cannot be altered. The state of the art as exemplified by Attwood et al. (Comput. Chem. 2001, Vol. 25(4), pp. 329-39) is such that "...we do not fully understand the rules of protein folding, so we cannot predict protein structure; and we cannot invariably diagnose protein function, given knowledge only of its sequence or structure in isolation" (see Abstract and entire publication). Furthermore, Ponting (Brief. Bioinform. March 2001, Vol. 2(1), pp. 19-29) states that "...predicting function by homology is a qualitative, rather than quantitative, process and requires particular care to be taken...due attention should be paid to all available clues to function, including orthologue identification, conservation of particular residue types, and the co-occurrence of domains in proteins" (See Abstract and entire publication).

The standard for meeting the enablement requirement is whether one of skill in the art can make the invention without undue experimentation. The amount of experimentation to make the claimed polynucleotide is enormous and entails selecting specific nucleotides to change (deletion, insertion, substitution, or combinations thereof) in a polynucleotide to make a polynucleotide that encodes a polypeptide that contains an amino acid sequence that is at least 70% identical to SEQ ID NO: 2 and determining by assays whether the polypeptide has activity. The specification does not provide guidance with respect to the specific structural/catalytic amino acids and the structural motifs essential for enzyme structure and activity/function which must be preserved. Thus, searching for the specific nucleotides to change (deletion, insertion, substitution, or combinations thereof) in a polynucleotide to make a polynucleotide that encodes a polypeptide that contains an amino acid sequence that is at least 70% identical to SEQ ID NO: 2 is well outside the realm of routine experimentation and predictability in the art of success in

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determining whether the resulting polypeptide has activity is extremely low since no information is provided by the specification regarding the specific catalytic amino acids and the structural motifs essential for enzyme structure and activity/function which must be preserved.

The Examiner finds that one skilled in the art would require additional guidance, such as information regarding the specific catalytic amino acids and the structural motifs essential for activity/function which must be preserved. Without such a guidance, the experimentation left to those skilled in the art is undue. Claims 2-4, 7, and 8 which depend from claim 1 are also rejected because they do not correct the defect of claim 1.

Claim Rejections - 35 U.S.C. § 112, 2nd Paragraph

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-4, 7, and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 the phrase "identical to the extent of at least 70% to a polynucleotide which codes for a polypeptide which comprises the amino acid sequence of" SEQ ID NO: 2" is vague and indefinite because the specific nucleotide sequence to which the claimed polynucleotide has 70% identity to is not known and not defined in the specification. Claims 2-4 and 7 which depend from claim 1 is also rejected because they do not correct the defect of claim 1.

In claim 2 the phrase "preferably recombinant" renders the claim vague and indefinite because it is not known if the claim polynucleotide is or is not further limited to a recombinant polynucleotide.

In claim 4 ii), the phrase "within the region of degeneration of the genetic code" renders the claim vague and indefinite because the meaning of the phrase is not known and not defined in the specification. In part (iii), the hybridization conditions are not recited and not known and thus render the claim vague and indefinite. In part (iv) the phrase "functionally neutral sense mutations" is vague and indefinite because the meaning of the phrase is not known and not defined in the specification.

Claim Rejections - 35 U.S.C. § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Eiglmeier et al. (GenBank Accession AL023591).

Eiglmeier et al. (GenBank Accession AL023591) teach a polynucleotide that contains at least 15 successive nucleotides encoding SEQ ID NO: 2 (see attached alignment). Thus, the reference teachings anticipate the of claimed invention.

10. Claims 4 is rejected under 35 U.S.C. 102(b) as being anticipated by Quax (Accession AAX29477).

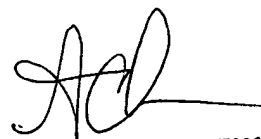
Quax. (Accession AAX29477) teach a polynucleotide that is expected to hybridize to SEQ ID NO: 1 since no stringent hybridization conditions have been recited (see attached alignment). Thus, the reference teachings anticipate the of claimed invention.

Conclusion

11. No claim is allowed.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christian L. Fronda whose telephone number is (703)305-1252. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, can be reached at (703)308-3804. The fax phone number for this Group is (703)308-0294. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is (703)308-0196.

CLF


PONNATHAPURACHUTAMURTHY
SUPERVISOR EXAMINER
TECHNICAL SERVICES